

ESTTA Tracking number: **ESTTA525997**

Filing date: **03/11/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Prometheus Global Media LLC
Granted to Date of previous extension	03/10/2013
Address	770 Broadway New York, NY 10003 UNITED STATES

Attorney information	Gene S. Winter St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905 UNITED STATES tvoloshchuk@ssjr.com, litigation@ssjr.com Phone:203-324-6155
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Applicant Information

Application No	85582882	Publication date	09/11/2012
Opposition Filing Date	03/11/2013	Opposition Period Ends	03/10/2013
Applicant	ABC - CLIO, LLC c/o Koenig & Associates 920 Garden Street Santa Barbara, CA 93101 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2010/10/25 First Use In Commerce: 2010/10/25

All goods and services in the class are opposed, namely: audio books in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; downloadable electronic publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; electronic publications, namely, books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and

professional books, and collections of digital and print resources featuring a wide variety of topics featuring secondary, higher education, and college level bibliographic reference materials, curriculum course materials, reference materials, and textbooks recorded on computer media

Class 016. First Use: 2010/10/25 First Use In Commerce: 2010/10/25

All goods and services in the class are opposed, namely: books in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; educational books featuring history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; educational publications, namely, books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the fields of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; non-fiction books on a variety of topics; publications, namely, books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the fields of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; reference books in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; resource books in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; scholarly books on various topics, namely, history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics

Class 035. First Use: 2010/10/25 First Use In Commerce: 2010/10/25

All goods and services in the class are opposed, namely: arranging of subscriptions for the publications of others; computerized on-line retail store services in the field of books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources; gift and sundries retail store services located in hotels; on-line retail store services featuring books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources;

promoting, advertising and marketing the on-line databases and electronic publications of others; retail store services featuring books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources; retail store services featuring books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources; provided via wireless communications

Class 041. First Use: 2010/10/25 First Use In Commerce: 2010/10/25


All goods and services in the class are opposed, namely: book publishing; digital video, audio, and multimedia publishing services; electronic publishing services, namely, publication of text and graphic works of others on CD, DVD, and on-line display featuring history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; multimedia publishing of books, magazines, journals, software, games, music, and electronic publications; non-downloadable electronic publications in the nature of books and teaching materials in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; online electronic publishing of books and periodicals; providing a website featuring non-downloadable publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; providing a website featuring resources, namely, a website featuring primarily non-downloadable publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics and also featuring non-downloadable software for CCC; providing a website featuring resources, namely, non-downloadable publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of History, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; providing on-line publications in the nature of an e-book in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; publication and editing of printed matter; publication of books; publication of electronic

magazines; publication of journals; publication of printed matter; publication of text books; publication of texts, books, magazines and other printed matter; publication of books

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2837926	Application Date	11/27/2002
Registration Date	05/04/2004	Foreign Priority Date	NONE
Word Mark	CLIO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2001/09/00 First Use In Commerce: 2001/09/00 PRINTED PUBLICATIONS IN THE NATURE OF BOOKS DIRECTED TO THE ADVERTISING INDUSTRY		

U.S. Registration No.	1134824	Application Date	10/30/1978
Registration Date	05/06/1980	Foreign Priority Date	NONE
Word Mark	CLIO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1963/06/01 First Use In Commerce: 1963/06/01 EDUCATIONAL AND ENTERTAINMENT SERVICES IN THE FIELDS OF ADVERTISING AND MARKETING COMMUNICATIONS-NAMELY, LIBRARY SERVICES, FILM PRODUCTION SERVICES AND CONDUCTING AWARDS CEREMONIES REWARDING EXCELLENCE IN THE PRODUCTION OF COMMERCIALS IN VARIOUS MEDIA		

Attachments	76470470#TMSN.gif (1 page)(bytes) Prometheus Notice of Opposition.pdf (20 pages)(2396698 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Tatyana Voloshchuk/
Name	Tatyana Voloshchuk
Date	03/11/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Prometheus Global Media LLC,	:	
	:	
Opposer,	:	
v.	:	Opposition No.
	:	[not yet assigned]
ABC-Clio, LLC.,	:	
	:	
Applicant.	:	

Re: U.S. Trademark Application Serial No. 85-582882 (ABC CLIO and Design)

NOTICE OF OPPOSITION

Opposer believes it will be damaged by the allowance and subsequent registration of the mark and the application referenced above, and hereby opposes registration thereof pursuant to Section 13 of the 1946 Trademark Act (15 U.S.C. §1063), alleging as grounds for opposition that:

1. Opposer, Prometheus Global Media LLC (“Opposer”) is a Delaware limited liability company with a business address at 770 Broadway, New York, NY, 10003, United States.

2. Opposer and its predecessors in interest have used the trademark CLIO continuously since at least as early as 1963 for a variety of goods and services related to entertainment, advertising and marketing, and awards shows for advertising.


3. Opposer is the owner by assignment of following U.S. trademark registrations for the CLIO trademark:

Mark	Registration No.	Date of Registration	Goods/Services
CLIO	2837926	May 4, 2004	Printed publications in the nature of books directed to the advertising industry

CLIO	1134824	May 6, 1980	Educational and entertainment services in the fields of advertising and marketing communications-namely, library services, film production services and conducting awards ceremonies rewarding excellence in the production of commercials in various media
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(“Opposer’s Registrations”). Copies of the registrations from the USPTO online database are attached herewith as Exhibit A and made of record in this proceeding pursuant to Trademark Rule 2.122(d).

4. Opposer’s Registrations are incontestable under 15 U.S.C. § 1065.
5. The records of the USPTO indicate that Applicant is a California limited liability company with a business address at: c/o Koenig & Associates, 920 Garden Street, Santa Barbara, California 93101.
6. The records of the USPTO indicate that Applicant is the owner of the following trademark application:

Mark	Application Serial No.	Filing Date	International Classes
 (“Opposed Mark”)	85-582882	March 28, 2012	9, 16, 35, 41

(“Opposed Application”).

7. The Opposed Application identifies a date of first use in commerce of October 25, 2010 for each identified class.

8. Opposer's rights in Opposer's Registrations and its common law rights in the CLIO trademark by virtue of use are prior in time to any date that Applicant has asserted in the Opposed Application.

9. Opposer's Registrations issued prior to Applicant's date of alleged first use of the Opposed Mark.

10. Opposer's Registrations issued prior to the filing date of the Opposed Application.

Claim I – Dilution

10. Opposer repeats and incorporates by reference all prior allegations.

11. As a result of the longstanding, prominent, and continuous use the CLIO trademark by Opposer and its predecessors in interest, the mark has become famous with respect to the goods and services identified in Opposer's Registrations, within the meaning of 15 U.S.C. § 1125.

12. The mark CLIO became famous within the meaning of 15 U.S.C. § 1125 prior to Applicant's adoption, any alleged first use of the Opposed Mark, and its filing of the Opposed Application.

13. Use and registration of the Opposed Mark by Applicant is likely to cause dilution of Opposer's famous CLIO trademarks within the meaning of 15 U.S.C. § 1125.

Claim II – False Association

14. Opposer repeats and incorporates by reference all prior allegations.

15. As a result of the longstanding, prominent, and continuous use of CLIO by Opposer, consumers have come to associate the mark with Opposer to extent that it has become Opposer's

name, identity, or persona with respect to the relevant goods and services so that the CLIO mark points solely and unmistakably to Opposer.

16. The trademark CLIO became Opposer's name, identity, or persona with respect to the relevant goods and services so that it points solely and unmistakably to Opposer prior to Applicant's adoption and any alleged first use of the Opposed Mark, and its filing of the Opposed Application.

17. The Opposed Mark is sufficiently similar to Opposer's previously used name, identity, or persona – CLIO – and would be recognized as such.

18. Applicant is not connected with Opposer or the goods/services that it provides under the ABC CLIO mark.

19. Opposer's name, identity, or persona is sufficiently famous with respect to the relevant goods and services, and the relevant public will assume that Applicant's goods and/or services are connected with Opposer.

20. Use and registration of the opposed mark will cause a false association with Opposer within the meaning of 15 U.S.C. § 1052(a).

Claim III – Likelihood of Confusion

21. Opposer repeats and incorporates by reference all prior allegations.

22. The goods and services identified in the Opposed Application are highly related to those marketed by Opposer under the CLIO trademark and identified in Opposer's Registrations.

23. The goods and services identified in the Opposed Application travel in the same channels of trade, are directed and/or offered to the same consumers, and sold and/or provided under the same commercial conditions as those identified in Opposer's Registrations and provided

by Opposer under the CLIO trademark.

24. In view of the similarities between Opposer's CLIO trademark and Opposer's Registrations, and the mark in the Opposed Application, compounded by the relatedness of the parties' respective goods and services, there is a likelihood that Applicant's products and services are likely to be seen as being sponsored by, affiliated with, or originating from Opposer.

25. The Opposed Mark so resembles Opposer's CLIO trademark and Opposer's Registrations, as to likely cause confusion, or to cause mistake, or to deceive as to the source of the identified goods and services within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

26. The use and registration of the mark in the Opposed Application will damage Opposer in the selling of its goods and services by causing a likelihood of confusion.

WHEREFORE, Opposer prays that said the Trademark Trial and Appeal Board deny registration to U.S. Trademark Application Serial No. **85-582882 (ABC CLIO and Design)** and otherwise sustain this opposition.

PROMETHEUS GLOBAL MEDIA LLC



March 11, 2013

Gene S. Winter (gwinter@ssjr.com)
Andy I. Corea (acorea@ssjr.com)
Tatyana Voloshchuk (tvoloshchuk@ssjr.com)
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905
Tel. (203) 324-6155
Facsimile (203) 327-1096
Email: litigation@ssjr.com

ATTORNEYS FOR OPPOSER

EXHIBIT A

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Mark: CLIO

CLIO

US Serial Number: 76470470

Application Filing Date: Nov. 27, 2002

US Registration Number: 2837926

Registration Date: May 04, 2004

Register: Principal

Mark Type: Trademark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: May 19, 2009

Publication Date: Feb. 10, 2004

Mark Information

Mark Literal Elements: CLIO

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: [1134824](#), [2041398](#), [2098679](#)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *...* identify additional (new) wording in the goods/services.

For: PRINTED PUBLICATIONS IN THE NATURE OF BOOKS DIRECTED TO THE ADVERTISING INDUSTRY

International Class: 016 - Primary Class

U.S Class: 002, 005, 022, 023, 029, 037, 038, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 2001

Use in Commerce: Sep. 2001

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: NIELSEN BUSINESS MEDIA, INC.

Owner Address: 770 BROADWAY
7th Floor
NEW YORK, NEW YORK 100039595
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Gene S. Winter
Attorney Primary Email Address: tm-pto@ssjr.com

Docket Number: 03670-T0011A
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Gene S. Winter
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD, CONNECTICUT 06905-5619
UNITED STATES
Phone: 203 324-6155
Correspondent e-mail: tm-pto@ssjr.com

Fax: 203 327-1096
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 19, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	69934
May 15, 2009	ASSIGNED TO PARALEGAL	69934
May 13, 2009	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
May 12, 2009	TEAS SECTION 8 & 15 RECEIVED	
Sep. 13, 2006	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
May 04, 2004	REGISTERED-PRINCIPAL REGISTER	
Feb. 10, 2004	PUBLISHED FOR OPPOSITION	
Jan. 21, 2004	NOTICE OF PUBLICATION	
Dec. 04, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 30, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Nov. 03, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Nov. 03, 2003	PAPER RECEIVED	
Apr. 30, 2003	NON-FINAL ACTION MAILED	
Apr. 22, 2003	ASSIGNED TO EXAMINER	76433

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None
File Location

Current Location: POST REGISTRATION

Date in Location: May 19, 2009

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Registrant: VNU Business Media, Inc.

Assignment 1 of 3

Conveyance: INTELLECTUAL PROPERTY SECURITY AGREEMENT
Reel/Frame: [3385/0528](#)
Date Recorded: Sep. 08, 2006
Supporting Documents: [assignment-tm-3385-0528.pdf](#)

Pages: 108

Name: [VNU BUSINESS MEDIA, INC.](#)
Legal Entity Type: CORPORATION

Assignor

Execution Date: Aug. 09, 2006
State or Country Where Organized: DELAWARE

Assignee

Name: CITIBANK, N.A., AS COLLATERAL AGENT

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: No Place Where Organized Found

Address: 390 GREENWICH STREET
NEW YORK, NEW YORK 10013

Correspondent

Correspondent Name: CORPORATION SERVICE COMPANY

Correspondent Address: 1133 AVENUE OF THE AMERICAS
SUITE 3100
NEW YORK, NY 10036

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: CHANGE OF NAME

Reel/Frame: 3984/0210

Pages: 4

Date Recorded: May 08, 2009

Supporting Documents: assignment-tm-3984-0210.pdf

Name: VNU BUSINESS MEDIA, INC.

Legal Entity Type: CORPORATION

Assignor

Execution Date: Jan. 24, 2007

State or Country Where Organized: DELAWARE

Assignee

Name: NIELSEN BUSINESS MEDIA, INC.

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 770 BROADWAY
NEW YORK, NEW YORK 10003

Correspondent

Correspondent Name: GENE S. WINTER

Correspondent Address: 986 BEDFORD STREET
ST. ONGE STEWARD JOHNSTON & REENS LLC
STAMFORD, CT 06905

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: 4143/0928

Pages: 27

Date Recorded: Feb. 04, 2010

Supporting Documents: assignment-tm-4143-0928.pdf

Name: E5 GLOBAL MEDIA, LLC

Legal Entity Type: LIMITED LIABILITY COMPANY

Assignor

Execution Date: Dec. 31, 2009

State or Country Where Organized: DELAWARE

Name: E5 GLOBAL MEDIA HOLDINGS, LLC

Legal Entity Type: LIMITED LIABILITY COMPANY

Execution Date: Dec. 31, 2009

State or Country Where Organized: DELAWARE

Assignee

Name: GUGGENHEIM CORPORATE FUNDING, LLC

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 135 EAST 57TH STREET
NEW YORK, NEW YORK 10022

Correspondent

Correspondent Name: MARIANN R. MURPHY

Correspondent Address: 353 N. CLARK STREET
JENNER & BLOCK LLP
CHICAGO, IL 60654-3456

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91208529](#)

Filing Date: Dec 19, 2012

Status: Pending

Status Date: Dec 19, 2012

Interlocutory Attorney: ROBERT COGGINS

Defendant

Name: Orpheus Media Research, Inc.

Correspondent Address: LAWRENCE H MEIER
DOWNS RACHLIN MARTIN PLLC
199 MAIN ST STE 600
BURLINGTON VT , 05401 8339
UNITED STATES

Correspondent e-mail: tmip@drm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Opposition Pending Plaintiff(s)	85416263	

Name: Prometheus Global Media, LLC

Correspondent Address: GENE S WINTER
STONGE STEWARD JOHNSTON REENS LLC
986 BEDFORD ST
STAMFORD CT , 06905
UNITED STATES

Correspondent e-mail: acorea@ssjr.com , litigation@ssjr.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Section 8 and 15 - Accepted and Acknowledged	76470470	2837926
CLIO	Renewed	73191144	1134824

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Dec 19, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Dec 19, 2012	Jan 28, 2013
3	PENDING, INSTITUTED	Dec 19, 2012	
4	NOTICE OF DEFAULT	Feb 19, 2013	

Type of Proceeding: Opposition

Proceeding Number: [91206416](#)

Filing Date: Aug 06, 2012

Status: Pending

Status Date: Aug 06, 2012

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Themis Solutions Inc.

Correspondent Address: JEFFREY A SMITH
MILLEN WHITE ZELANO & BRANIGAN PC
2200 CLARENDON BLVD STE 1400
ARLINGTON VA , 22201-3360
UNITED STATES

Correspondent e-mail: culver@mwzb.com , docketing@mwzb.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Opposition Pending Plaintiff(s)	77626275	

Name: Prometheus Global Media, LLC

Correspondent Address: GENE S WINTER
ST ONGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD CT , 06905
UNITED STATES

Correspondent e-mail: acorea@ssjr.com , litigation@ssjr.com

Associated marks

Serial Registration

Mark	Application Status	Number	Number
CLIO	Section 8 and 15 - Accepted and Acknowledged	<u>76470470</u>	<u>2837926</u>
CLIO	Renewed	<u>73191144</u>	<u>1134824</u>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 06, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 06, 2012	Sep 15, 2012
3	PENDING, INSTITUTED	Aug 06, 2012	
4	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Sep 10, 2012	
5	SUSPENDED	Sep 10, 2012	
6	STIPULATION FOR AN EXTENSION OF TIME	Oct 09, 2012	
7	EXTENSION OF TIME GRANTED	Oct 09, 2012	
8	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Nov 09, 2012	
9	SUSPENDED	Nov 09, 2012	
10	STIPULATION FOR AN EXTENSION OF TIME	Jan 10, 2013	
11	EXTENSION OF TIME GRANTED	Jan 10, 2013	
12	STIPULATION FOR AN EXTENSION OF TIME	Feb 12, 2013	
13	EXTENSION OF TIME GRANTED	Feb 12, 2013	
14	W/DRAW OF OPPOSITION	Feb 15, 2013	

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Mark: CLIO

US Serial Number: 73191144
US Registration Number: 1134824
Register: Principal
Mark Type: Service Mark
Status: The registration has been renewed.
Status Date: Apr. 22, 2010

Application Filing Date: Oct. 30, 1978
Registration Date: May 06, 1980

Mark Information

Mark Literal Elements: CLIO
Standard Character Claim: No
Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: EDUCATIONAL AND ENTERTAINMENT SERVICES IN THE FIELDS OF ADVERTISING AND MARKETING COMMUNICATIONS-
NAMELY, LIBRARY SERVICES, FILM PRODUCTION SERVICES AND CONDUCTING AWARDS CEREMONIES REWARDING
EXCELLENCE IN THE PRODUCTION OF COMMERCIALS IN VARIOUS MEDIA

International Class: 041 - Primary Class
Class Status: ACTIVE
Basis: 1(a)
First Use: Jun. 01, 1963

U.S Class: 107
Use in Commerce: Jun. 01, 1963

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: e5 Global Media, LLC
Owner Address: 770 BROADWAY
NEW YORK, NEW YORK 100039595
UNITED STATES
Legal Entity Type: LIMITED LIABILITY COMPANY
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney Name: Gene S. Winter
Attorney Primary Email: tm-pto@ssjr.com
Address:

Attorney of Record
Docket Number: 03670-T0003B
Attorney Email: Yes
Authorized:

Correspondent

Correspondent Gene S. Winter
Name/Address: ST. ONGE STEWARD JOHNSTON & REENS LLC
 986 BEDFORD STREET
 STAMFORD, CONNECTICUT 06905-5619
 UNITED STATES

Phone: 203-324-6155

Fax: 203-327-1096

Correspondent e-mail: tm-pto@ssjr.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 22, 2010	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	76533
Apr. 22, 2010	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Apr. 20, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76533
Apr. 14, 2010	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Apr. 13, 2010	TEAS SECTION 8 & 9 RECEIVED	
Apr. 02, 2010	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 29, 2008	CASE FILE IN TICRS	
Sep. 13, 2006	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 22, 2000	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Dec. 22, 2000	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
May 01, 2000	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Aug. 11, 1986	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
May 06, 1986	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: May 06, 2010

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Apr. 22, 2010

Assignment Abstract Of Title Information

Summary

Total Assignments: 9

Registrant: CLIO ENTERPRISES, INC.

Assignment 1 of 9

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0824/0236](#)

Pages: 4

Date Recorded: Nov. 01, 1991

Supporting Documents: No Supporting Documents Available

Assignor

Name: [CLIO ENTERPRISES, INC.](#)

Execution Date: Sep. 27, 1991

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW YORK

Assignee

Name: [RATNY, RUTH L.](#)

Legal Entity Type: INDIVIDUAL

Citizenship: No Citizenship Found

Address: 720 N. WABASH

CHICAGO, ILLINOIS 60611

Correspondent

Correspondent Name: MICHAEL R. GRAHAM
Correspondent Address: WILLIAM BRINKS OLDS HOFER GILSON & LIONE
NBC TOWER, 455 NORTH CITYFRONT PLAZA DR.
SUITE 3600
CHICAGO, IL 60611-5599

Domestic Representative - Not Found

Assignment 2 of 9

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL
Reel/Frame: 0931/0421 **Pages:** 4
Date Recorded: Feb. 05, 1993
Supporting Documents: No Supporting Documents Available

Assignor
Name: RATNY, RUTH L. **Execution Date:** Feb. 05, 1993
Legal Entity Type: INDIVIDUAL **Citizenship:** UNITED STATES

Assignee
Name: SIEGAL, BARRY P. **Citizenship:** UNITED STATES
Legal Entity Type: INDIVIDUAL
Address: C/O BARRY P. SIEGAL LTD.
79 W. MONROE STREET SUITE 1020
CHICAGO, ILLINOIS 60603

Correspondent

Correspondent Name: DRESSLER, GOLDSMITH, SHORE, SUTKER ET AL
Correspondent Address: ALLEN J. HOOVER
TWO PRUDENTIAL PLAZA-SUITE 4700
180 NORTH STETSON AVENUE
CHICAGO, IL 60601

Domestic Representative - Not Found

Assignment 3 of 9

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL
Reel/Frame: 0940/0455 **Pages:** 2
Date Recorded: Mar. 03, 1993
Supporting Documents: No Supporting Documents Available

Assignor
Name: SIEGAL, BARRY P., C/O BARRY P. SIEGAL LTD. **Execution Date:** Mar. 02, 1993
Legal Entity Type: INDIVIDUAL **Citizenship:** No Citizenship Found

Assignee
Name: CLIO L.P. **State or Country Where Organized:** No Place Where Organized Found
Legal Entity Type: LIMITED PARTNERSHIP
Address: 79 WEST MONROE STREET SUITE 1000
CHICAGO, ILLINOIS 60603

Correspondent

Correspondent Name: DRESSLER, GOLDSMITH, SHORE, SUTKER ET AL
Correspondent Address: ATTN: ALLEN J. HOOVER
TWO PRUDENTIAL PLAZA - SUITE 4700
180 NORTH STETSON AVENUE
CHICAGO, IL 60601

Domestic Representative - Not Found

Assignment 4 of 9

Conveyance: ASSIGNS THE ENTIRE INTEREST
Reel/Frame: 1694/0649 **Pages:** 4
Date Recorded: Feb. 27, 1998
Supporting Documents: No Supporting Documents Available

Assignor
Name: CLIO L.P. **Execution Date:** Sep. 30, 1997
Legal Entity Type: LIMITED PARTNERSHIP **State or Country Where Organized:** ILLINOIS

Assignee

Name: BPI COMMUNICATIONS INC.

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** DELAWARE

Address: 1515 BROADWAY
NEW YORK, NEW YORK 10036

Correspondent

Correspondent Name: HUGHES HUBBARD & REED LLP

Correspondent Address: PERLA M. KUHN
ONE BATTERY PARK PLAZA, 18TH FLOOR
NEW YORK, NY 10004

Domestic Representative - Not Found

Assignment 5 of 9

Conveyance: MERGER

Reel/Frame: 2853/0763

Pages: 4

Date Recorded: Oct. 27, 2003

Supporting Documents: assignment-tm-2853-0763.pdf

Name: BPI COMMUNICATIONS, INC.

Legal Entity Type: CORPORATION

Execution Date: Jan. 01, 2002

**State or Country Where
Organized:** DELAWARE

Assignee

Name: VNU BUSINESS MEDIA, INC.

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** DELAWARE

Address: 770 BROADWAY
NEW YORK, NEW YORK 10003-9595

Correspondent

Correspondent Name: ST.ONGE STEWARD JOHNSTON & REENS LLC

Correspondent Address: GENE S. WINTER
986 BEDFORD STREET
STAMFORD, CT 06905-5619

Domestic Representative - Not Found

Assignment 6 of 9

Conveyance: INTELLECTUAL PROPERTY SECURITY AGREEMENT

Reel/Frame: 3385/0528

Pages: 108

Date Recorded: Sep. 08, 2006

Supporting Documents: assignment-tm-3385-0528.pdf

Name: VNU BUSINESS MEDIA, INC.

Legal Entity Type: CORPORATION

Execution Date: Aug. 09, 2006

**State or Country Where
Organized:** DELAWARE

Assignee

Name: CITIBANK, N.A., AS COLLATERAL AGENT

Legal Entity Type: NATIONAL BANKING ASSOCIATION

**State or Country Where
Organized:** No Place Where Organized Found

Address: 390 GREENWICH STREET
NEW YORK, NEW YORK 10013

Correspondent

Correspondent Name: CORPORATION SERVICE COMPANY

Correspondent Address: 1133 AVENUE OF THE AMERICAS
SUITE 3100
NEW YORK, NY 10036

Domestic Representative - Not Found

Assignment 7 of 9

Conveyance: CHANGE OF NAME

Reel/Frame: 4182/0953

Pages: 4

Date Recorded: Apr. 09, 2010

Supporting Documents: assignment-tm-4182-0953.pdf

Name: VNU BUSINESS MEDIA, INC.

Legal Entity Type: CORPORATION

Execution Date: Jan. 24, 2007

State or Country Where DELAWARE

Organized:

Assignee

Name: NIELSEN BUSINESS MEDIA, INC.

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 770 BROADWAY
NEW YORK, NEW YORK 10003

Correspondent

Correspondent Name: GENE S. WINTER

Correspondent Address: 986 BEDFORD STREET
ST. ONGE STEWARD JOHNSTON & REENS
STAMFORD, CT 06905

Domestic Representative - Not Found

Assignment 8 of 9

Conveyance: SECURITY INTEREST

Reel/Frame: 4143/0928

Pages: 27

Date Recorded: Feb. 04, 2010

Supporting Documents: assignment-tm-4143-0928.pdf

Assignor

Name: E5 GLOBAL MEDIA, LLC

Execution Date: Dec. 31, 2009

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Name: E5 GLOBAL MEDIA HOLDINGS, LLC

Execution Date: Dec. 31, 2009

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Assignee

Name: GUGGENHEIM CORPORATE FUNDING, LLC

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 135 EAST 57TH STREET
NEW YORK, NEW YORK 10022

Correspondent

Correspondent Name: MARIANN R. MURPHY

Correspondent Address: 353 N. CLARK STREET
JENNER & BLOCK LLP
CHICAGO, IL 60654-3456

Domestic Representative - Not Found

Assignment 9 of 9

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 4183/0134

Pages: 19

Date Recorded: Apr. 09, 2010

Supporting Documents: assignment-tm-4183-0134.pdf

Assignor

Name: NIELSEN BUSINESS MEDIA, INC.

Execution Date: Dec. 31, 2009

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: E5 GLOBAL MEDIA, LLC

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 770 BROADWAY
NEW YORK, NEW YORK 10003

Correspondent

Correspondent Name: GENE S. WINTER

Correspondent Address: 986 BEDFORD STREET
ST. ONGE STEWARD JOHNSTON & REENS
STAMFORD, CT 06905

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: 91208529

Filing Date: Dec 19, 2012

Status: Pending

Status Date: Dec 19, 2012

Interlocutory Attorney: ROBERT COGGINS

Defendant

Name: Orpheus Media Research, Inc.

Correspondent Address: LAWRENCE H MEIER
DOWNS RACHLIN MARTIN PLLC
199 MAIN ST STE 600
BURLINGTON VT , 05401 8339
UNITED STATES

Correspondent e-mail: tmjp@drm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Opposition Pending Plaintiff(s)	<u>85416263</u>	

Name: Prometheus Global Media, LLC

Correspondent Address: GENE S WINTER
STONGE STEWARD JOHNSTON REENS LLC
986 BEDFORD ST
STAMFORD CT , 06905
UNITED STATES

Correspondent e-mail: acorea@ssjr.com , litigation@ssjr.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Section 8 and 15 - Accepted and Acknowledged	<u>76470470</u>	<u>2837926</u>
CLIO	Renewed	<u>73191144</u>	<u>1134824</u>

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Dec 19, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Dec 19, 2012	Jan 28, 2013
3	PENDING, INSTITUTED	Dec 19, 2012	
4	NOTICE OF DEFAULT	Feb 19, 2013	

Type of Proceeding: Opposition

Proceeding Number: 91206416

Filing Date: Aug 06, 2012

Status: Pending

Status Date: Aug 06, 2012

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Themis Solutions Inc.

Correspondent Address: JEFFREY A SMITH
MILLEN WHITE ZELANO & BRANIGAN PC
2200 CLARENDON BLVD STE 1400
ARLINGTON VA , 22201-3360
UNITED STATES

Correspondent e-mail: culver@mwzb.com , docketing@mwzb.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Opposition Pending Plaintiff(s)	<u>77626275</u>	

Name: Prometheus Global Media, LLC

Correspondent Address: GENE S WINTER
ST ONGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD CT , 06905
UNITED STATES

Correspondent e-mail: acorea@ssjr.com , litigation@ssjr.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Section 8 and 15 - Accepted and Acknowledged	<u>76470470</u>	<u>2837926</u>
CLIO	Renewed	<u>73191144</u>	<u>1134824</u>

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 06, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 06, 2012	Sep 15, 2012
3	PENDING, INSTITUTED	Aug 06, 2012	
4	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Sep 10, 2012	
5	SUSPENDED	Sep 10, 2012	
6	STIPULATION FOR AN EXTENSION OF TIME	Oct 09, 2012	
7	EXTENSION OF TIME GRANTED	Oct 09, 2012	
8	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Nov 09, 2012	
9	SUSPENDED	Nov 09, 2012	
10	STIPULATION FOR AN EXTENSION OF TIME	Jan 10, 2013	
11	EXTENSION OF TIME GRANTED	Jan 10, 2013	
12	STIPULATION FOR AN EXTENSION OF TIME	Feb 12, 2013	
13	EXTENSION OF TIME GRANTED	Feb 12, 2013	
14	W/DRAW OF OPPOSITION	Feb 15, 2013	

Type of Proceeding: Opposition

Proceeding Number: 91123274

Filing Date: Jun 11, 2001

Status: Terminated

Status Date: Apr 29, 2003

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: CLIO COMMUNICATIONS, INC.

Correspondent Address: SHARON J. ADAMS
ADAMS LAW OFFICE
1867 YGNACIO VALLEY ROAD #230
WALNUT CREEK CA , 94598

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO COMMUNICATIONS, INC.	Abandoned - After Inter-Partes Decision	<u>76073959</u>	

Plaintiff(s)

Name: BPI COMMUNICATIONS INC.

Correspondent Address: GENE S. WINTER
ST. ORNGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD CT , 06905

Associated marks

Mark	Application Status	Serial Number	Registration Number
CLIO	Renewed	<u>73191144</u>	<u>1134824</u>

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jun 11, 2001	
2	NOTICE SENT; TRIAL DATES RESET; ANSWER DUE	Jun 22, 2001	Aug 01, 2001
3	PENDING, INSTITUTED	Jun 22, 2001	
4	ANSWER	Jul 30, 2001	
5	PLN MOT TO SUSPEND PROCEEDING PEND C/A DEF OPP TO MOT TO SUSPEND PROCEEDING PENDING	Dec 26, 2001	

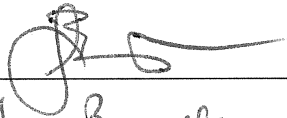
6	C/A; DECLAR OF SUSAN LEHMAN	Jan 09, 2002
7	PLN REPLY TO OPP TO MOTION TO SUSPEND PENDING CIVIL ACTION	Jan 28, 2002
8	PROCEEDING SUSPENDED PEND CIVIL ACTION	Mar 12, 2002
9	DEF'S NOT OF EXPRESS ABANDONMENT	Jun 02, 2002
10	BOARD'S DECISION: SUSTAINED	Apr 29, 2003
11	TERMINATED	Apr 29, 2003

CERTIFICATE OF SERVICE

This is to certify that a true copy of the foregoing **NOTICE OF OPPOSITION** was served by first class mail, postage prepaid on the Correspondent for the Applicant at the address identified in USPTO records:

Kurt Koenig
Koenig & Associates
P.O. Box 1140
Summerland, California 93067-1140
United States

Mar 11, 2013
Date


Joan Burnett